

REMARKS

This is in response to the office action dated April 19, 2011, which rejected all pending claims as unpatentable over one or more references under 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a). A request for continuing examination is made. This response is believed to address the grounds for rejection and place the application in a condition for further examination.

Amendment to the Specification

After the Title, please delete the section entitled "Cross-Reference to Related Applications" in its entirety and substitute the following in its stead.

--Cross Reference to Related Applications

This application is a continuing application of 09/634,725, filed August 5, 2000 (now pending), which is a continuation-in-part application of application Ser. No. 09/478,796, filed on January 7, 2000 (now USP 6,845,448 B1). This application is also related to Ser. No. 12/799,945 filed May 5, 2010, which is a continuation application of application Ser. No. 09/634,725, filed August 5, 2000, and to Ser. No. 13/089, 775 filed on April 19, 2011 (now pending), which is a continuation application of 09/634,725, filed August 5, 2000. This application is further related to Ser. No. 10/987,917 filed November 12, 2004, which is a continuation application of application Ser. No. 09/478,796, and Ser. No. 13/090,066 filed April 19, 2011, which is a continuation application of Ser. No. 10/987,917, and Ser. Nos. 13/089,775, 13/090,222 filed April 19, 2011, and 13/091,387 filed April 19, 2011 each of which is a continuation application of Ser. No. 09/634,725.--

Amendment to the Claims

Claims are amended to replace the term "digital item" with --information-- as used in the parent application for clarification. Independent claims are also amended to recite that the

communication network (Internet) is capable of transmitting and/or receiving information objects, which information comprises voice, video, data and/or text or any combinations thereof. See S. No. 09/478,796 at page 20, lines 18-19. In addition, the claims recite “repository” instead of “library”. These changes do not add any new matter. Examiner is respectfully requested to review and enter the amendment.

Argument regarding rejected claims

1. All claims are rejected under 35 U.S.C. § 103 as being unpatentable over a combination of references with Meyer being the primary reference and Glassman or Atkinson or Barberis as secondary references.

2. The Examiner has the initial burden of proof of *prima facie* obviousness. See *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir.1992) (In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent.) The burden of production and proof regarding obviousness is on the Patent Office. See *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984).

3. The Supreme Court held that the factual considerations in determining obviousness include “the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved.” *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966); see also, *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (“teachings of references can be combined only if there is some suggestion or incentive to do so.”) (emphasis in original). The Examiner did not identify the field of endeavor, the scope and content of the prior art and whether the subject matter as a whole would have been obvious to one of skill in the art. Examiner combined materials from three non-analogous areas of art.

4. "Patent examination is necessarily conducted by hindsight, with complete knowledge of the applicant's invention, and the courts have recognized the subjective aspects of determining whether an inventor would reasonably be motivated to go to the field in which the examiner found the reference, in order to solve the problem confronting the inventor. We have reminded ourselves and the PTO that it is necessary to consider "the reality of the circumstances." *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992).

5. The predecessor court for the Federal Circuit stated:

In resolving the question of obviousness under 35 U.S.C. § 103, we presume full knowledge by the inventor of all the prior art in the field of his endeavor. However, with regard to prior art outside the field of his endeavor, we only presume knowledge from those arts reasonably pertinent to the particular problem with which the inventor was involved. *In re Antle*, 444 F.2d 1168, 1171-72, 58 CCPA 1382, 1387, 170 USPQ 285, 287-88 (1971). The rationale behind this rule precluding rejections based on combination of teachings of references from nonanalogous arts is the realization that an inventor could not possibly be aware of every teaching in every art. Thus, we attempt to more closely approximate the reality of the circumstances surrounding the making of an invention by only presuming knowledge by the inventor of prior art in the field of his endeavor and in analogous arts.

The determination that a reference is from a nonanalogous art is therefore two-fold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved.

In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979). In order for a combination to be made to defeat a claim, there should be some relationship between the applicant's field of endeavor and the identified art in order to be qualified for a combination.

Meyer is not a pertinent reference

Meyer is not in the pertinent field of endeavor. Meyer does not describe a service-provider operated online repository in which a plurality of users have accounts with the server computer, and in which each of a plurality of users is allocated storage area to store their respective copyrighted information objects as recited in the claims under examination.

In addition, the claims are now rewritten to use the language from the parent application. As the substitutions of the term --repository-- for “library” and --information object-- for “digital item” show, these are disclosed in the parent application S. No. 09/478,796. For example, the parent application discloses storing personal preferences (movies, ... books, ...). See *id.*, at page 10, lines 16-17. The ‘796 application also discloses that using an information object may be controlled by way of a contract or copyright. See *id.*, at page 18, lines 18-22. Therefore, it is believed that Meyer is not pertinent art that could be used against the instant independent claims.

Barberis is antedated by all the claims

Each of the presented claims is entitled to the priority date of at least August 5, 2000, which is believed to remove Barberis (U.S. Pat. App. Pub. No. 20040021686 (filed July 2, 2002)) as a reference. Reconsideration is respectfully requested.

Glassman teaches away from the combination

As stated in an earlier paper, Glassman teaches away from the claimed combination. See M.P.E.P. § 2145 (stating It is not correct to combine references where the references teach away from their combination); *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983) (The claimed catalyst is not obvious in view of a reference that expressly excluded one of the components that formed the claimed catalyst.) Therefore Glassman is not a correct reference. Reconsideration is respectfully requested.

Atkinson is directed toward non-analogous art

In Atkinson, “[a] certification or signature is incorporated in a computer program, an executable file, or code to assure its authenticity and integrity, particularly for receiving it over an open computer network like the Internet.” See Abstract. As stated in an earlier response to office action, Atkinson is directed toward a different field of endeavor and there is no evidence

of why one of ordinary skill in the art would look to Atkinson to solve any problem in order to arrive at the claims under examination. Reconsideration is respectfully requested.

Conclusion

The Commissioner is respectfully requested to establish an RCE and conduct further examination. A fee computation sheet is attached at the end of this paper. The required fee is paid via credit card.

Respectfully Submitted,

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